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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,533	01/26/2001	Madoka Mitsuoka	1405.1033/JDH	4908
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STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ROSEN, NICHOLAS D	
			ART UNIT	PAPER NUMBER
			3625	

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/769,533	<b>Applicant(s)</b> MITSUOKA ET AL.	
	<b>Examiner</b> Nicholas D. Rosen	<b>Art Unit</b> 3625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 March 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-10 is/are rejected.
- 7) ☒ Claim(s) 2-4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Claims 1-10 have been examined.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 10 is rejected under 35 U.S.C. 102(e) as being anticipated by Buettgenbach et al. (U.S. Patent Application Publication 2002/0032613). Buettgenbach discloses a method for processing for delivery of an item, comprising: accepting at a computer delivery terms of the item wherein said delivery terms are entered by a prospective recipient of the item after the item has been ordered (paragraphs 37, 38, and 98-100).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1, 5, 6, and 7**

Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buettgenbach et al. (U.S. Patent Application Publication 2002/0032613) in view of official notice; claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buettgenbach et al. (U.S. Patent Application Publication 2002/0032613). As per claim 1, Buettgenbach discloses a method for managing delivery of products that have been ordered, including: presenting a screen which accepts delivery applications of the products with a provider of the products, and accepting applications for delivery of said products from a provider of said products (paragraphs 31, 37, and 38; Figure 1); assigning application ID's to said applications (paragraphs 15, 49, 103, and 104); presenting a screen which notifies a delivery recipient of the product, and accepting a designation of delivery terms (paragraph 38; the disclosure of using a Web site and Web browser makes a screen obvious); and presenting said delivery recipient with a screen displaying at least a product scheduled to be delivered to said delivery recipient

(paragraph 48). Buettgenbach does not expressly disclose a presenting step of presenting said delivery recipient with a list of the products scheduled to be delivered to said delivery recipient and said application ID, although this can be considered as disclosed if a list with one item is still a list (paragraph 48). However, the duplication of known parts is held to be obvious to one of ordinary skill in the art (*St. Regis Paper Co. vs. Bemis Co.*, 193 USPQ 8, 11; 549 F. 2<sup>nd</sup>. 833 (7<sup>th</sup> Circuit 1977); *In re Harza*, 124 USPQ 378, 380; 274 F. 2<sup>nd</sup>. 269, CCPA (1960)). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to present said delivery recipient a list of products scheduled to be delivered, for the obvious advantage of making arrangements for delivery when more than one product was involved.

Buettgenbach discloses presenting a screen which accepts designation of delivery terms for the applications from the recipient (in the case when the buyer is the recipient; see paragraph 38), and accepting designation of delivery terms on the screen from the delivery recipient after orders of the products (paragraphs 31, 37, and 38; Figure 1); and discloses presenting information on the products for which delivery terms have been designated, the designated delivery terms, and the delivery recipient to a delivery business being specified by the designated delivery terms (paragraph 40). Buettgenbach does not expressly disclose presenting a screen displaying this information, but does disclose sending a message which can be e-mail (paragraph 40). Official notice is taken that it is well known to view e-mail messages on screens; hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at

the time of applicant's invention to present a screen displaying the products, etc., for the obvious advantage of enabling employees of the delivery business to read the e-mail and take appropriate action.

As per claim 6, Buettgenbach discloses judging whether said delivery recipient is the party that ordered said product(s) (paragraphs 77 and 84); and accepting cancellations of orders for said identified products (paragraphs 83 through 88); and notifying the provider of said products for which the specified order by said application has been cancelled, according to a result of said judging (paragraph 88).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buettgenbach et al. (U.S. Patent Application Publication 2002/0032613) and official notice as applied to claim 1 above, and further in view of Mandler (U.S. Patent 5,732,400). Buettgenbach discloses a user judging step of judging whether said delivery recipient is the party that ordered said product(s) (paragraph 77).

Buettgenbach does not disclose notifying the provider of said products that the products specified by said application ID's have been purchased after said term accepting step, according to a result of said judging, but it is well known to notify product providers that products have been purchased, as taught, for example, by Mandler (column 3, lines 48-65; column 4, lines 20-42). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to notify the provider as claimed, for the obvious advantage, as taught in Mandler, of arranging for the shipping and delivery of ordered products.

Claim 7 is closely parallel to claim 1, and rejected on essentially the same grounds, except that claim 7 does not recite presenting screens, so official notice that it is well known to present screens is not requisite in regard to claim 7.

It is noted that claim 7 uses "means for" language. Nonetheless, it is not treated as invoking 35 U.S.C. 112, sixth paragraph. If Applicant wishes to invoke 35 U.S.C. 112, sixth paragraph, Applicant should provide an explicit statement to that effect. 35 U.S.C. 112, sixth paragraph states:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

#### **Claims 8 and 9**

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buettgenbach et al. (U.S. Patent Application Publication 2002/0032613) in view of Hartman et al. (U.S. Patent 5,960,411) and Walker et al. (U.S. Patent 5,862,223). Buettgenbach discloses a delivery information service method, including: receiving a delivery request for an article (paragraph 31, 37, and 38). Storing a received delivery request in a storage device is inherent from further manipulation of the request data (e.g., paragraphs 51 and 52). Buettgenbach does not disclose searching a storage device for pending deliveries with the same delivery recipient as the delivery recipient of said delivery request, but Hartman teaches combining orders to be sent to the same recipient into multiple-item orders, implying search of pending deliveries to enable

Art Unit: 3625

relevant orders to be found and combined (column 8, lines 27-55; column 8, lines 1-25).

Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to search the storage device for pending deliveries with the same delivery recipient, for the stated advantage of minimizing shipping costs and purchaser confusion, or the obvious advantage of arranging for delivery recipients to make fewer trips to pick up available products from Buettgenbach's Will-Call Centers.

Buettgenbach does not expressly disclose referring to an address table and extracting the notification address of the delivery recipient, but it is well known to maintain files of people's addresses, and extract the addresses therefrom, as taught, for example, by Walker (Figure 12; column 24, lines 6-21). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to refer to an address table and extract the notification address therefrom, for the obvious advantage of delivering the article or articles to the correct address.

Buettgenbach discloses that, based on desired delivery terms, instructions are made for delivery to the delivery recipient of the article scheduled for delivery, said instructions being given to a delivery business that has been designated by the desired conditions or that matches desired conditions (paragraph 40).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buettgenbach et al. (U.S. Patent Application Publication 2002/0032613) in view of Hartman et al. (U.S. Patent 5,960,411) and Walker et al. (U.S. Patent 5,862,223).



Art Unit: 3625

Claim 8 recites, in essence, a computer program for carrying out the method of claim 9, and is therefore rejected on essentially the grounds set forth above with regard to claim 9.

### **Claim 10**

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over the anonymous article "SmartShip.com Announces Multi-Carrier Shipping and Tracking Function for E-Commerce," hereinafter "SmartShip," in view of Hartman et al. (U.S. Patent 5,960,411). "SmartShip" discloses a method for processing for delivery of an item, comprising: accepting at a computer delivery terms of the item wherein said delivery terms are entered by a prospective recipient of the item after the prospective recipient is, at least, "ready to purchase items" (entire article, especially paragraph beginning "By linking three information elements"). "SmartShip" does not expressly disclose that the item has been ordered, although the language can be read as indicating that the item has been ordered, or at least selected to be ordered, but it is well known to provide delivery information after an item has been ordered, or at least selected for ordering, as taught, for example, by Hartman (column 1, lines 46-65); hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the item to have been ordered, for the obvious advantage of arranging for the delivery of ordered items.

***Allowable Subject Matter***

Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and further amended to overcome the objection set forth above.

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record, Buettgenbach et al. (U.S. Patent Application Publication Application Publication 2002/0032613), discloses or makes obvious the limitations of claim 1, as set forth above. However, neither Buettgenbach nor any other prior art of record discloses, teaches, or reasonably suggests a group accepting step of accepting formation of a group and designation of group members from said delivery recipients; and said presenting of a notification screen further including a group notification step of giving notification of a list of products scheduled for delivery to other members of the group to which the delivery recipient belongs, and the application ID's therefor. Buettgenbach does disclose designating an alternative recipient to pick up ordered product(s) (paragraph 38); it is known to accept formation of a group and notify the members of such a group (e.g., forming an e-mail list, and sending a post to all members of such a list), and it is known to leave a message and/or a package with a neighbor if the intended recipient of a package isn't available when the deliveryman comes by, but these do not suffice to teach the recited limitations.

Claims 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record, Buettgenbach et al. (U.S. Patent Application Publication 2002/0032613), discloses or makes obvious the limitations of claim 1, as set forth above. Buettgenbach does not expressly disclose that said application accepting step further includes a step of accepting an application for delivery of a first product of said products and an application for delivery of a second product of said products, with corresponding first and second delivery terms, but it is well known to order multiple products. However, Buettgenbach does not disclose a judging step of judging whether prior to delivery of the first product, a second delivery term is designated for the second product; and a term changing step of changing the first delivery term set for the first product to the second delivery term set for the second product according to a result of the judging step (nor the slightly different limitations of claim 4). No other prior art of record discloses, teaches, or reasonably suggests these limitations. The closest prior art for these limitations is Kawasaki (Japanese Published Patent Application 11-272752 A), and Kawasaki, although related to the modification of delivery dates, does not teach the limitations recited in either claim. It would be surprising if no one had thought to deliver two products to the same recipient together, even if they might otherwise have been delivered at the same time, but doing so is not held to meet the detailed limitations of claims 3 or 4.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection. Examiner's rejections no longer rely on Tartal, to which Applicant rightly objected on the ground that the provisional application to which priority was claimed did not properly teach the limitations at issue.

Also, in response to Applicant's traversal of official notice, Examiner has used actual prior art to establish the facts of which official notice was formerly taken, although the adequacy of Applicant's traversal might be questioned, based on the teaching set forth below:

The Manual of Patent Examination Procedure (2144.03 (C)) states, in regard to traversal of Official Notice:

C. If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding with Adequate Evidence.

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without reference to the examiner's assertion of official notice would be inadequate.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Daniels et al. (U.S. Patent 5,758,126) disclose a customizable bidirectional EDI translation system (note columns 11 and 12, especially column 12, lines 39-45). Moreno (U.S. Patent Application Publication 2002/0035515) discloses a system and method for remotely coordinating the secure delivery of goods.

Ross (WO 94/27264 A1) discloses an apparatus and method for notifying a recipient of an unscheduled delivery.

The U.S. Provisional Applications 60/197,499 (priority for Buettgenbach) and 60/218,400 (priority for Moreno) are also made of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's current acting supervisor, Mark Fadok, can be reached at 571-272-6755. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Non-official/draft communications can be faxed to the examiner at 571-273-6762.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 3625

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Nicholas D. Rosen*  
**NICHOLAS D. ROSEN**  
**PRIMARY EXAMINER**

April 13, 2006